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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
CHANKONG, DOHM	
ART UNIT	**PAPER NUMBER**
2152	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/922,348	BORGER ET AL.	
	Examiner	Art Unit	
	Dohm Chankong	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicant's remarks, filed 2.16.2006. No claims were amended. Claims 1-62 are presented for further examination.

2. This is a final rejection.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant's arguments will be addressed in turn.

I. Claim 1

Applicant argues in substance: (A) Jimenez fails to disclose conversion of web content from a text-based format to an audio format; (B) Jimenez fails to disclose serving Web content in an audio format to a user via a telephone link; (C) Jimenez fails to disclose retrieving an advertisement and inserting the advertisement into requested web content; (D) Logan fails to disclose forwarding web content and advertisement to a transcoder for conversion to an audio format; (E) Logan fails to disclose an advertisement server; and (F) there is no motivation to combine Jimenez with Logan. Applicant's arguments are all unpersuasive and force an interpretation of the references that are entirely inconsistent with the purposes and disclosure of both the Jimenez and Logan references.

A. Jimenez discloses conversion of web content from a text-based format to an audio format.

Applicant argues that the cited section discloses "the conversion of telephony (not Web content) into Internet Protocol (web content), and then converting audio portions of such internet protocol into text". Applicant's remarks, pg. 17, ¶2. Applicant's remarks focus entirely on one section of the Jimenez reference and are unpersuasive.

Jimenez discloses in his specification the functionality of converting web content into an audio format such that it may be heard by a user of a telephony device [see *for example*, 0022 : "A document can be a HTML page..., or some other type of file...the system 100 retrieves, converts to audio output and plays to the user on the telephony device"].

B. Jimenez discloses serving Web content in an audio format to a user via a telephone link.

Applicant again simply focuses on one section of the Jimenez reference. Contrary to Applicant's belief, Jimenez discloses the functionality of converting web content into an audio format, and delivering the converted output to a telephony device [see *for example*, 0022 : "A document can be a HTML page..., or some other type of file...the system 100 retrieves, converts to audio output and plays to the user on the telephony device"]. Presumably, since the converted audio output is being delivered to a telephony device, the

audio output is served via a telephony link [see *for example*, Figure 2 «item 108» | 0028].

C. Jimenez discloses retrieving an advertisement and inserting the advertisement into requested web content.

Applicant acknowledges that Jimenez discloses that advertisements may be linked to audio content. However, Applicant also asserts that "nothing in...Jimenez or Logan...suggest that such advertisements can be converted to audio". Applicant's remarks, pg. 18, ¶1. The limitation merely calls for the retrieval and insertion of an advertisement which Jimenez discloses [see *for example*, 0046, 0051, 0054].

The limitation of converting the advertisement into an audio format is addressed in the response with respect to the Logan reference, below.

D. Logan discloses forwarding web content and advertisement to a transcoder for conversion to an audio format.

Applicant asserts that the cited portions of the Logan reference are disparate and have nothing to do with teaching a means for converting web content and an advertisement to an audio format at a transcoder. Applicant's remarks, pg. 19, ¶1. Applicant's assertion again focus on the cited portions, ignore the references as a whole and force an unduly narrow interpretation of the Logan reference.

Logan discloses converting program data from text form into audio form [column 6 «lines 22-32»]. Logan then discloses a wide variety of data, including advertising content and other text information from news sources or libraries, is considered program data [Figure 1 «items 130, 135» | column 6 «lines 6-12 and 22-25»]. One of ordinary skill in the art could reasonably infer from these teachings that Logan clearly indicates a means of converting web and advertising content from text form into audio form. Logan discloses that storing program content as text would be beneficial for users who could more quickly download content and advertising text information from a server. Thus, Applicant's assertion that the cited portions are disparate is unpersuasive when viewed in support of Logan's entire disclosure.

E. Logan discloses an advertisement server.

Applicant argues that the cited portion "does not disclose an advertising server" nor does the cited portion "does not even mention the word advertisement." Applicant's remarks, pg. 19 ¶ 2. Applicant's arguments again simply focus on one section of the reference and are clearly erroneous.

Within the cited portion, Logan discloses a server containing advertising segments, the advertising being in the form of either audio, text or image forms [column 5 «lines 58-59» | column 6 «lines 6-12»]. Additionally, Logan's figure clearly discloses a server with advertising content [Figure 1 «item 135»]. It seems within the intuition of one of ordinary skill in the art

that a web server that stores advertising content may be reasonably construed as an "advertising server".

F. The motivation to combine comes from the references.

First, Logan and Jimenez are related towards the same invention of providing program content to users by converting text data to audio forms such that programs may be listened at the user end. Thus, Logan's web content and advertisement functionality could be combined with Jimenez with a reasonable expectation of success.

Logan discloses that incorporating web content with advertisements for users to provide a mutually beneficial relationship between the listeners and program providers whereby users may obtain credits by simply listening to advertising [abstract]. The advertising is associated with the program data to insure a certain amount of interest by the user [column 10 «line 55» to column 11 «line 3» | column 25 «lines 36-50»].

These benefits would substantially improve Jimenez who simply plays advertisements indiscriminately. Thus, Logan's web content and advertisement teaching would improve Jimenez's system by providing a means of incorporating related advertisements with web content to better target users.

II. Claim 9

Applicant's arguments with respect to claim 9 are not persuasive. Applicant argues in substance that the references do not disclose notifying an advertisement server of user interaction with an advertisement. Applicant then opines that "advertisement functionality has nothing to do with billing being accurate". Applicant's remarks, pg. 21, ¶1.

Applicant's arguments take a unduly narrow view of the Logan reference. Applicant argues that" most of the cited portion is irrelevant to anything to do with advertisements". Applicant's remarks, pg. 20, ¶3. This is clearly erroneous. The cited portion in question discusses usage records of the subscriber. Logan discloses that usage records are created when a player plays advertising and program segments [column 27 «lines 45-47»]. The discussion within the cited portion is thus related to creating a user record of which advertisements were viewed by the user.

The usage record indicates the amount of interaction, such as the starting time of when the advertisement was played, the level at which the volume was played and the playing speed at which the advertisement was viewed, that the user had with the advertisement or program content [column 27 «line 65» to column 28 «line 5»]. Clearly this information would only be useful to the advertiser. The information within the user record is sent to the web (advertising) server [Figure 1 «item 143»] such that the advertiser can view the amount of user interaction with an advertisement to determine the advertisement's effectiveness [column 28 «lines 58-65»].

Applicant also argues that advertisements has nothing to do with billing being accurate. This seems argument lacks any force given Applicant's own specification, which discloses that the purpose of monitoring a user's interaction is to determine the effectiveness of an advertising campaign. Applicant's specification, pg. 5, lines 10-12. As already discussed above, Logan's purpose of "notifying the advertisement server of user interaction with an advertisement" is to promote an advertisement's effectiveness [column 28 «lines 60-61»]. Logan clearly discloses a means of notifying a server of a user's interaction with advertising content for the purpose of helping advertisers.

III. Claim 57

Claims 57-62 were rejected under two grounds of rejection. Applicant traverses both.

A. Wu in view of Davis

Applicant broadly asserts, without any support, that Wu and Davis references do not disclose, teach or suggest the elements of the claim. Applicant does not point to any specific element that the references fail to disclose and thus Applicant's argument is not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Wu and Davis come from the Davis reference to provide a more efficient system for advertisers.

B. Logan, in view of Jimenez

Applicant again focuses on the cited portion of the reference and ignores the reference as a whole. The Office's remarks above apply with respect to claim 57. Logan discloses text-to-audio conversion [column 6 «lines 22-27»]. If Applicant maintains the position that Logan fails to teach the concept of text to audio conversion, the Office requests Applicant to more expressly explain how Logan's disclosure of "information...available in text form...may be converted to compressed audio form" fails to disclose text-to-audio conversion.

Logan clearly views advertising as interactive. An advertiser may view "the precise extent to which advertising was actually presented and paying only for advertising known to have been effectively delivered" [column 28 «lines 58-61»]. This includes monitoring the start time, the volume and the playing speed of the displayed advertisement.

Logan did not expressly disclose forwarding an advertisement to be inserted into web content at the web server. Jimenez expressly discloses attaching advertisements to web content [0054]. The motivation to combine

references may come from the references themselves or from what is well known in the art. One of ordinary skill in the art would desire to combine Jimenez's server insertion functionality into Logan such as to relieve client-side processing.

IV. Conclusion

For the foregoing reasons, Applicant's arguments are not persuasive and the claim rejections set forth in the previous action, filed 10.11.2005 are maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-56 are rejected under 35 U.S.C § 103(a) as being unpatentable over Jimenez et al, U.S Patent Publication, 2001|0048676 ["Jimenez"], in view of Logan et al, U.S Patent. 6.199.076 ["Logan"].

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action, filed 10.11.2005.

5. Claims 57-62 are rejected under 35 U.S.C § 103(a) as being unpatentable over Logan, in view of Jimenez.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action filed 10.11.2005.

7. Claim 57, 58, 59, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (2003/0212759) in view of Davis et al. (US 5,796,952).

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action, filed 10.11.2005.

9. Claim 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (2003/0212759) in view of Davis et al. (US 5,796,952) as applied to claim 57 further in view of Hickman (US 2001/0033564).

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action, filed 10.11.2005.

11. Claims 1-4, 6-15, 17-22, 24-33, 35-41, 43-51 and 53-56 are rejected under 35 U.S.C § 103(a) as being unpatentable over Logan.

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action, filed 10.11.2005.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DC

BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER